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PATENT

PETITIONS OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Chin-Chi TENG et al

Art Unit: 2812

Application No: 10/043,458

Examiner:

Filed: January 9, 2002

For: CLOCK TREE SYNTHESIS FOR A
HIERARCHICALLY PARTITIONED IC
LAYOUT

PETITION REGARDING NOTICE OF RESCISSION OF
NONPUBLICATION REQUEST
CONDITIONAL PETITION FOR REVIVAL
UNDER 37 CFR 1.137(f)

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Attention: Office of Petitions

Sir:

Applicant filed this application with a nonpublication request under 37 CFR 1.213(a). Applicant filed a corresponding International application on January 8, 2003. Applicant filed a Notice of Rescission of Nonpublication Request on January 27, 2003. On or after April 11, 2003 applicant became aware (a) that the Office considers that the requirement for a notification of foreign filing under 35 USC 122(b)(2)(B)(iii) is independent of a rescission of a nonpublication request under 35 USC 122(b)(2)(B)(ii), and (b) that the Office considers that a rescission of a nonpublication request is not a notice of foreign filing under 35 USC 122(b)(2)(B)(iii).

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PRINCIPAL PETITION

Applicant requests that the Office should acknowledge that applicant's Notice of Rescission of Nonpublication Request, which was filed before April 11, 2003 (when the Office drew practitioners' attention to its view that the requirement for a notification of foreign filing is independent of a rescission of a nonpublication request) and not later than 45 days after the date of filing of the International application, is an adequate notification under 35 USC 122(b)(2)(B)(iii).

In support of this request, applicant draws attention to the following facts: (1) prior to April 11, 2003 the Office viewed the official form then in effect for rescinding a nonpublication request (Form PTO-SB/38 (10-01), copy enclosed) to be an adequate notification of foreign filing under 35 USC 122(b)(2)(B)(iii), (2) Form PTO-SB/38 in effect on January 29, 2003 and until at least April 18, 2003 makes no reference in the body of the form to 35 USC 122(b)(2)(B)(iii) or 37 CFR 1.213(c), (3) 37 CFR 1.33(b) requires that in order for a paper filed in an application to be recognized as the act of the applicant it must be signed, and (4) the signature line on Form PTO-SB/36 in effect on January 29, 2003 is above the note that refers to 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) and therefore the note, as such, is not signed by the applicant or the applicant's representative and is not the applicant's or the representative's act. If a statement "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)," when made on a paper captioned REQUEST TO RESCIND PREVIOUS NONPUBLICATION REQUEST 35 U.S.C. 122(b)(2)(B)(ii), is considered to be notice of a subsequent foreign or international filing under 35 USC 122(b)(2)(B)(iii), applicant's notice of rescission should similarly be considered a notification under 35 USC 122(b)(2)(B)(iii).

Applicant requests that his representative's confusion over the requirements of 35 USC 122(b)(2)(B) and 37 CFR 1.213(b) and (c) should be excused, at least to the extent of accepting the

notice of rescission filed January 27, 2003 as a notification under 35 USC 122(b)(2)(B)(iii). Applicant submits that prior to April 11, 2003 it was reasonable to have viewed the notice of rescission as cancelling or abrogating the previous nonpublication request¹, such that it would be considered that no nonpublication request had been made and therefore no need for notification under 35 USC 122(b)(2)(B)(iii) arose. Under this interpretation, if an applicant made a nonpublication request and subsequently filed an corresponding International application, under 35 USC 122(b)(2)(B)(iii) the applicant was required to notify the Director of the filing of the International application within 45 days unless he had already rescinded, and thereby nullified, the nonpublication request. This interpretation is reasonable because the purpose of the notification under 35 USC 122(b)(2)(B)(iii) is to allow timely publication of the U.S. application in the event that the applicant files a corresponding application in a foreign country or under a multilateral international agreement that requires eighteen-month publication, and the applicant thereby constructively waives the right to prevent publication of the U.S. application before issue of the patent. Applicant believes that if the applicant files a notice of rescission of nonpublication request under 35 USC 122(b)(2)(B)(ii) no later than 45 days after filing an International application, a notification under 35 USC 122(b)(2)(B)(iii) serves no purpose that is not served by the notice of rescission.

Applicant believes that his representative was not alone in being confused regarding the appropriate interpretation of 35 USC 122(b)(2)(B)(ii) and 35 USC 122(b)(2)(B)(iii). Confusion on the part of Office personnel can be inferred from the changes that were made to Form PTO/SB/36 after April 11, 2003: evidently,

1. The standard dictionary definition of rescission is "an act of rescinding, annulling, or vacating or of cancelling or abrogating."

notwithstanding the third paragraph of the notice of April 11, 2003, the Office was uncertain whether the unsigned note on Form PTO/SB/36 (10-01) was an adequate notification under 35 USC 122(b) (2) (B) (iii).

Please charge any fee required for filing this petition to Deposit Account 19-2560.

CONDITIONAL PETITION 1

In the event that applicant's Principal Petition is not granted, applicant requests that the Office should acknowledge that applicant has, in fact, filed a timely and explicit notification under 35 USC 122(b) (2) (B) (iii). Applicant's International application, which was filed at the Patent and Trademark Office in its capacity as receiving office, includes a cover sheet (copy attached) that refers to this U.S. application by application number and filing date. In addition, sheet 4 of the Request (copy attached) refers to this application by application number and filing date. Applicant's act of filing the International application therefore notified the Director of the filing of the International application not later than 45 days after filing of the International application.

Please charge any fee required for filing this petition to Deposit Account 19-2560.

CONDITIONAL PETITION 2

In the event the Office is unable or unwilling to grant applicant's Principal Petition or Conditional Petition 1 and takes the position that this application became abandoned, applicant petitions for revival of this application under 37 CFR 1.137(b) and 37 CFR 1.137(f).

The undersigned, who filed the Notice of Rescission and was aware of the filing of the International application, states that the entire delay in filing this notification from the due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Please charge the fee of \$1,300.00 under 37 CFR 1.17(m)
(large entity) to Deposit Account 19-2560.

Respectfully submitted,



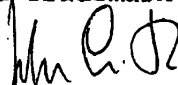
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Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile
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below.



John Smith-Hill

5/28/03
Date

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FACSIMILE COVER SHEET

To: Office of Petitions

From: John Smith-Hill

Firm: US PATENT AND
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Date: May 28, 2003

Fax: 1-703-308-6916

Our ref: SILI 2282

Your ref: 10/043,458

Pages: Cover + 8